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SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX AZ 85004-0001

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SEP 14 2004

OFFICE OF PETITIONS

In re Application of
Clarot, et al. :
Application No. 10/664,839 :
Filed: 16 September, 2003 :
Attorney Docket No. 33205.1900 :
:

ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 10 May, 2004.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the application was filed on 16 September, 2003, without, *inter alia*, a fully executed oath or declaration; and
- on 5 December, 2003, the Office mailed a Notice to File Missing Parts with a reply due absent extension of time on or before 5 February, 2004;
- on 10 May, 2004 (over a 5 May, 2004, certificate of mailing), Petitioner filed, *inter alia* (a request and fee for a three- (3-) month extension) an oath/declaration signed by named inventor Tim Clarot, but without the signature of Charles Hensley (Mr. Hensley), a petition under 37 C.F.R. §1.47, and narrative by Petitioner Wendy S. Neal (Reg. No. 45,615) and Kelley A. Rasmussen of Matrixx Initiatives, however, while the statement suggests that a copy of the application may have been provided to Mr. Hensley, it does not appear from the transmittal that the entire application was sent to Mr. Hensley as required by statute and regulation.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted.

And a reasonable effort must be made to ascertain a current or last known address.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

CONCLUSION

The materials submitted thus far do not clearly evidence that the entire application was sent to the alleged non-signing inventor after a reasonable effort is made to determine a current valid address for the non-signing inventor. Petitioner should submit a copy of the transmittal letter and should state the address in the petition over Petitioner's signature and registration number.

Therefore, the instant petition hereby is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)²
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

¹ See: MPEP 409.03(b).

² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By FAX: IFW Formal Filings
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(Effective 28 September, 2004: (571-273-0025)
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Lobby/Room 1B03
Crystal Plaza Two
220 20th Street S.
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to the undersigned at 703-305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions